

REMARKS

Claims 1, 3, 4, 6, 8, 10, 12, 27, and 28 are pending and under consideration. Claims 1, 4, 6, 8, 10, and 12 are amended herein. Claims 2, 5, 7, 9, 11, and 13 to 26 are canceled herein without prejudice or disclaimer. Claim 28 is added herein. Support for the amendments to the claims may be found in the claims as originally filed. Support for new claim 28 may be found at page 12, lines 15 and 16 of the specification, and in Fig. 8. Reconsideration is requested based on the foregoing amendment and the following remarks.

Interview Summary

The Applicants submit the following summary of the telephone interview that took place December 19, 2006 between the undersigned representative of the Applicants and the Examiner and her supervisor.

Telephone Conference:

The Applicants thank the Examiners for the many courtesies extended to the undersigned representative of the Applicants during the telephone interview that took place December 19, 2006.

Among the issues discussed during the Interview was the above-mentioned amendment to claim 1, in which the subject matter of former claim 2 has been included in claim 1. As also discussed during the Interview, the amendment to claim 1 is believed to overcome the combination of U.S. Patent No. 5,999,971 to Buckland and U.S. Publication No. 2003/0097361 to Huang et al. Claims 4, 6, 8, 10, and 12 have been amended in a manner similar to claim 1, and are thus also believed to overcome the combination of Buckland and Huang.

Claim Rejections - 35 U.S.C. § 112:

Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as indefinite. The Office Action cites the phrase "allowable or allowed," as rendering claim 1 indefinite at page 2, in section 3. The phrase "allowable or allowed," however, does not appear in claim 1. M.P.E.P. § 2173.05(d), which was also cited in the Office Action, deals with exemplary claim language like "for example," and "such as," which is not the case here either. Even if the phrase "allowable or allowed," did appear in claim 1, it would not amount to *exemplary* claim language. If further discussion would help resolve this issue, the courtesy of a telephone call to the undersigned representative of the Applicants is earnestly solicited. Otherwise, withdrawal of the rejection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 1, 3, 4, 6, 8, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,999,971 to Buckland (hereinafter "Buckland"). The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration of the rejection is earnestly solicited.

The Office Action acknowledges graciously at pages 3 and 4, in section 6, that Buckland shows no "accepting headline information of the browsable information, and allowable user information of a user who is allowed to browse the browsable information, and storage location information of the browsable information; registering the accepted headline information and the allowable user information in association with the storage location information; receiving identification information identifying a user, which identification information is sent from the terminal apparatus to the central apparatus; extracting a hyperlink title and a URL of a storage location, which are associated with the received identification information as allowable user information, based on the received identification information; generating a document containing a hyperlink including the extracted hyperlink title wherein hyperlink to the extracted URL of the storage location is defined; and transmitting the generated document to the terminal apparatus."

The Office Action asserts at page 4, also in section 6, that:

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. This limitation are just generating information and the information is not being used. Thus, this descriptive material will not distinguish the claimed invention from the prior in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Neither *In re Gulack* nor *In re Lowry*, however supports the assertion that a limitation, which is termed "descriptive material" in the Office Action, will not distinguish the claimed invention from the prior in terms of patentability. *Gulack* in particular, *reversed* the Board of Patent Appeals and Interferences, saying:

The fact that printed matter by itself is not patentable subject matter, because nonstatutory, is no reason for ignoring it when the claim is directed to a combination. Here there is a new and unobvious functional relationship between a measuring *receptable*, volumetric *indicia* thereon indicating volume in a certain ratio to actual volume, and the legend indicating the ratio, and in our judgment the appeal of claims properly define this relationship.

Thus, for the Office Action here to dismiss the above-mentioned elements in the claims as nonfunctional descriptive material, and give them no patentable weight, is directly contrary to the holding in *In re Gulack*.

Similarly, in *In re Lowry*, the Court also reversed the Board of Patent Appeals and Interferences, saying in the Conclusion:

The board erred by denying patentable weight to Lowry's data structure limitations.

Thus, for the Office Action here to deny patentable weight to positively recited elements in the claims is directly contrary to the holding in *In re Lowry*.

Finally, according to M.P.E.P. § 2143.03, *all* claim limitations must be taught or suggested by the prior art to establish prima facie obviousness of a claimed invention. In particular as provided therein:

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Since, as acknowledged graciously in the Office Action, Buckland does not show all of the elements recited in claims 1, 3, 4, 6, 8, 10, and 12, and, according to M.P.E.P. § 2143.03, all claim limitations must be taught or suggested in Buckland in order for claims 1, 3, 4, 6, 8, 10, and 12 to be rendered unpatentable, claims 1, 3, 4, 6, 8, 10, and 12 are submitted to be allowable over Buckland. Withdrawal of the rejection of claims 1, 3, 4, 6, 8, 10, and 12 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 1, 3, 4, 6, 8, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckland in view of U.S. Publication No. 2003/0097361 to Huang et al. ("Huang"). The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

The Office Action acknowledges at page 6, in section 7, that Buckland shows no "extracting a hyperlink title and a URL of an individual storage location based on the received identification information and the registered authorized user information and generating a document containing a hyperlink including the extracted hyperlink title wherein hyperlink to the extracted URL of the individual storage location is defined." The Office Action proposes to compensate for this deficiency by combining Buckland with Huang, asserting in the last paragraph at page 6, continuing at page 7, that:

It would be obvious to a person of ordinary skill in the art at the time the invention was made to have modified Buckland by the teaching of Huang et al, because extracting a hyperlink title and a URL of a storage location, which are associated with the received identification information as allowable user information, based on the received identification information; and

generating a document containing a hyperlink including the extracted hyperlink title wherein hyperlink to the extracted URL of the storage location is defined, would enable the disclosing method to be more secure, because disclosing two types of browser information, one that has information open to the public and another that is kept secret from the public, provides the mechanism for the right user to access that information.

Huang, however, does not appear to show these limitations either. In neither Buckland nor Huang, in particular, is there any “authorized user information of a user authorized to browse the browsable information,” standing between the user and the title and the URL. Thus even if Buckland and Huang were combined, the claimed invention would not result.

Furthermore, modifying Buckland as proposed by the Office Action would change the principle of operation of Buckland. Modifications that change the principle of operation of a reference are prohibited by M.P.E.P. § 2143.01. In particular,

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Here, in Buckland, “if it is determined that the client does not include the first site data block, then the control site is controlled to produce a control site data block having both control site identification data and a client identifier,” as described at column 2, lines 20-24. Thus, if an *unidentified* client tries to access a network site in Buckland, the system *provides* the user with an identifier. Buckland, thus, does not appear to be particular about whether the user is authorized or not, merely whether the user has been identified. This is exactly the opposite of the claimed invention, which checks for “authorized user information,” before authorizing a user to browse the browsable information. Since modifying Buckland as proposed by the Office Action would change the principle of operation of Buckland, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*.

The second clause of claim 1 recites:

Allowable user information of a user who is allowed to browse the browsable information.

Neither Buckland nor Huang teach, disclose, or suggest, “allowable user information of a user who is allowed to browse the browsable information, and storage location information of the

browsable information” as recited in claim 1. As Buckland, rather, describes in the Abstract, a client identifier is *supplied* to an unidentified client:

If it is determined that the client does not include the first site data block, then the control site is controlled to produce a control site data block having both control site identification data and a client identifier. The control site data block then is transmitted from the control site to the client.

Therefore, Buckland, far from worrying about whether a user is allowed to browse information, actually provides the user with identification on the fly.

Huang, for its part, does not bother to identify a user at all, let alone consider whether the user is allowed to browse information. As Huang, rather, describes in the Abstract:

A message center based desktop organizational and management system that includes a set of applications centered around and integrated with a message center.

There is little doubt that a user will be allowed to access their own desktop. Thus, neither Buckland nor Huang need any “allowable user information”, let alone “extracting a hyperlink title and a URL of a storage location, which are associated with the received identification information as allowable user information, based on the received identification information and generating a document containing a hyperlink including the extracted hyperlink title wherein hyperlink to the extracted URL of the individual storage location is defined,” as also recited in claim 1.

The eighth clause of claim 1 recites:

Wherein the accepting further accepts limitation information limiting browsing of the browsable information according to whether the request is sent through the communication network or through an auxiliary communication network different from said communication network.

Neither Buckland nor Huang teach, disclose, or suggest, “limiting browsing of the browsable information according to whether the request is sent through the communication network or through an auxiliary communication network different from said communication network,” as discussed during the interview held December 19, 2006. Thus, even if Buckland were combined with Huang, the claimed invention would not result. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claim 3 depends from claim 1 and adds additional distinguishing elements. Claim 3 is thus also submitted to be allowable. Withdrawal of the rejection of claim 3 is earnestly solicited.

Claims 4, 6, 8, 10, and 12:

Claims 4, 6, 8, 10, and 12 recite:

Authorized user information of a user authorized to browse the browsable information.

Neither Buckland nor Huang teach, disclose, or suggest, "authorized user information of a user authorized to browse the browsable information," as discussed above with respect to the rejection of claim 1.

Claims 4, 6, 8, 10, and 12 recite further:

Extracting a hyperlink title and a URL of the individual storage location based on the received identification information and the registered authorized user information.

Neither Buckland nor Huang teach, disclose, or suggest, "extracting a hyperlink title and a URL of the individual storage location based on the received identification information and the registered authorized user information," as discussed above with respect to the rejection of claim 1. Even if the user login to which Huang refers at paragraph [0101] were equated to the claimed "received identification information," there is still no "registered authorized user information." In Huang, rather, once the user is authorized to access the network, they are free to access any data they like. In particular, as described at paragraph [0116] of Huang:

[0116] After a successful login, the user's personalized virtual desktop 1220 is transmitted, received, and displayed. Desktop 1220 corresponds generally to browser display 300 in FIG. 3. The user can then activate the features of the virtual computer by activating the appropriate icon from virtual desktop 1220. In general, through virtual desktop 1220, the user has access to applications, files, news and information, and additional features.

Since, in Huang, once the user is authorized to access the network, they are free to access any data they like, Huang shows no "extracting a hyperlink title and a URL of the individual storage location based on the received identification information and the registered authorized user information," either, and thus cannot make up for the deficiencies of Buckland with respect to claims 4, 6, 8, 10, and 12.

Finally, claims 4, 6, 8, 10, and 12 recite:

Limiting browsing of the browsable information according to whether the request is sent through the communication network or through an auxiliary communication network different from said communication network.

Neither Buckland nor Huang teach, disclose, or suggest, "limiting browsing of the browsable information according to whether the request is sent through the communication network or through an auxiliary communication network different from said communication network," as discussed above with respect to the rejection of claim 1. Claims 4, 6, 8, 10, and 12 are submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim

1. Withdrawal of the rejection of claims 4, 6, 8, 10, and 12 is earnestly solicited.

Claim 27:

The applicants acknowledge with appreciation the allowance of claim 27.

Claim 28:

The seventh and eighth clauses of claim 28 recite:

Generating a document containing a hyperlink including the extracted hyperlink title wherein the hyperlink to the extracted URL of the individual storage location is defined without referring to the limitation information if the request was sent through an intramural communication network.

And:

Generating the document containing the hyperlink including the extracted hyperlink title wherein the hyperlink to the extracted URL of the individual storage location is defined by referring to the limitation information if the request was sent through an extramural communication network.

Claim 28 is believed to be allowable as well, for the reasons discussed in the above-mentioned interview held December 19, 2006, as well as those discussed in the interview held July 6, 2006.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1, 3, 4, 6, 8, 10, 12, 27, and 28 are allowable over the cited references. Allowance of all claims 1, 3, 4, 6, 8, 10, 12, 27, and 28 and of this entire application is therefore respectfully requested.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 10/026,458

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 28 DEC 06

By: 

Thomas E. McKiernan
Registration No. 37,889

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501